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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,793	12/24/2003	Katsuto Tanahashi	032206	9788
38834 7590 02/07/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER MONDT, JOHANNES P	
			ART UNIT	PAPER NUMBER
			3663	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/743,793	TANAHASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Johannes P. Mondt	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/22/07 has been entered.

### ***Information Disclosure Statement***

The examiner has considered the items listed in the Information Disclosure Statement (IDS) filed 6/22/05 and has previously acknowledged this through submission of Form PTO-1449. However, a misspelling of the second author of the second item from above in "Other Documents" was noted, and accordingly an annotated Form PTO-1449 is enclosed.

### ***Response to Amendment***

Amendment filed with said RCE forms the basis for this office action. Comments on Remarks submitted with said Amendment are included below under "Response to Arguments".

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4-6 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara et al (US 2003/0159644 A1) in view of prior art as admitted by Applicants ("APAA"). Yonehara et al teach a semiconductor substrate 1 ([0075] and [0113]) comprising a front face and a rear face that are both mirror-polished ([0095]), wherein said semiconductor substrate contains boron at a concentration in the range  $1 \times 10^{17} - 10^{20} \text{ cm}^{-3}$  (see [0149]) which range overlaps the claimed range in the sub-range  $10^{17} - 2 \times 10^{17} \text{ cm}^{-3}$ . In this regard it is noted that a *prima facie* case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art or when the ranges of a claimed composition do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. In re Peterson, 65 USPQ2d 1379 (CA FC 2003).

Yonehara also teach that a crystal layer 10 is provided on the front face ([0150]), and that a minimum value of the concentration of boron, [B] (in atoms/  $\text{cm}^3$ ) is defined for a required thickness, "t" (in  $\mu\text{m}$ ), said required thickness being  $t=100 \text{ nm}=0.1 \mu\text{m}$  (see [0150]) of the crystal layer that satisfies the inequality as claimed, i.e., said minimum concentration being  $[B]=10^{17} \text{ cm}^{-3}$  (see [0149]), because  $\exp(0.21 \times 0.1) \cong 1.021 \leq 10^{17} / [(2.2 \pm 0.2) 10^{16}] \cong R$ , wherein  $4.17 \leq R \leq 5$  within 1% accuracy, hence falls in the claimed relation for said required thickness and within the range of boron concentration (*N.B.: please note that an upper portion of the crystalline layer 3 is porous and hence is (1) another layer and (2) not truly crystalline when taken as a whole, because the porosity destroys the translational symmetry along the lattice vectors which*

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*is a defining property of crystallinity). Yonehara et al do not necessarily teach the limitation that said semiconductor substrate meets a criterion of "an SFQR value  $\leq 70$  nm as a flatness of the front face". However, as admitted by Applicants as many as 40% of all conventionally produced wafers satisfy said criterion and therefore, by rule of statistics all one of ordinary skills in the art has to do is make enough of said wafers in order to be certain to have one that satisfies said criterion. With regard to claim 14, in addition Yonehara et al teach a semiconductor element formed on the front face of said semiconductor substrate (solar battery: see Figures 16 and [0072]).*

*On claim 4: a maximum value of a thickness of the crystal layer 10 is defined by Yonehara to be 20  $\mu\text{m}$  (see [0150]), which does satisfy the claimed inequality for a required concentration of boron [B] (in atoms/ $\text{cm}^3$ ), said concentration being required to be in the interval  $10^{17} - 10^{20} \text{ cm}^{-3}$  (see [0149]), hence  $10^{20}$  being one of all required values, because  $\exp(0.21 \times 20) = \exp(4.2) \cong 66.7 \leq 4166 \leq 10^{20} / (2.2 + 0.2) \times 10^{16} \leq 10^{20} / (2.2 \pm 0.2) \times 10^{16}$ .*

*On claim 5: the crystal layer 10 is a silicon crystal layer ([0078]) formed by epitaxial growth ([0149]).*

*On claim 6: the crystal layer is a silicon-germanium alloy crystal layer ([0078]).*

3. **Claims 7-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara and APAA as applied to claim 2 above, and further in view of Fitzgerald (US 2002/0123167 A1). As detailed claim 2 is unpatentable over Yonehara et al in view of APAA. Neither necessarily teach the claimed layered structure of SiGe and Si. However, (a) there is a specific suggestion by Yonehara et al that a layered structure of

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SiGe on silicon could be used to generate stress in an SOI structure ([0411]-[0412]), while Fitzgerald teaches an SOI structure with a layered SOI composition, in particular SiGe on Si (Figure 1) for the specific purpose to enhance electron mobility (see "Background of the Invention"). *Motivation* to follow the suggestion by Yonehara et al and the teaching by Fitzgerald immediately derives from the improved electron mobility and consequent higher operational speed.

*On claims 8 and 9*, both Yonehara et al ([0411]-[412] and Fitzgerald ([0032] and Figures 4) teach the silicon layer to be formed in an SOI structure, i.e., inherently a structure in which the silicon crystal layer is separated by a silicon oxide layer, i.e., said semiconductor substrate is an SOI substrate wherein the crystal layer is an upper silicon crystal layer separated by a silicon dioxide layer (loc.cit.).

*On claim 10*: while Yonehara et al teach SIMOX as a method in the prior art for making an SOI substrate ([0006]) Applicant is reminded that the limitation of claim 10 fails to further limit the device and instead only further limits the method of making. Therefore, the further limitation defined by claim 10 fails to distinguish over the prior art.

*On claim 11*: similarly, while Yonehara et al teach bonding steps the limitation of claim 11 fails to further limit the device but instead only limits its method of making. Hence the further limitation fails to distinguish over the prior art.

4. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara et al as and APAA applied to claim 1 above, and further in view of Hurley (5,698,474).

*As detailed above, claim 1 is unpatentable over Yonehara et al in view of APAA, neither necessarily teaching the further limitation defined by claim 12.*

*However, it would have been obvious to include said further limitation in view of Hurley, who, in a patent on semiconductor wafer manufacturing for integrated circuits, hence analogous art, teaches exposing the entire backside as a flat, thinned and mirror polished for the specific purpose of creating a window suitable for inspection (see title, abstract and col. 5, lines 8-12). Motivation for the inclusion of the teaching by Hurley in this regard in the invention by Yonehara derives from the need to inspect the quality of the result of the manufacturing process.*

5. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonehara et al and APAA as applied to claim 1 above, and further in view of Steckl et al (5,759,908). As detailed above, claim 1 is unpatentable over Yonehara et al in view of APAA. Neither necessarily teach the further limitation defined by claim 13. However, it would have been obvious to include SiC as a substrate material for an SOI in view of Steckl et al, who teach silicon carbide SOI structures (title, abstract) for the specific purpose of *inter alia* its higher breakdown voltage (see col. 1, l. 10-22). *Motivation to replace the silicon substrate with the silicon carbide substrate derives immediately from said higher breakdown voltage.*

### ***Response to Arguments***

Applicant's arguments filed 1/22/07 have been fully considered but they are not persuasive. In particular, applicant's allegation that a non-existent substrate has been

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utilized in order to make the rejection (page 6 of Remarks) does not appear to recognize the obviousness rejection is supported by case law, in particular "In re Peterson" as cited in the previous office action according to which it has been held that overlap of claimed and prior art range constitutes a prima facie case of obviousness, and so does the case when said ranges are sufficiently close such that one skilled in the art would have expected them to have the same properties. Applicant's criticism appears to be directed to the principle of the case law on which examiner relies, rather than the application of said case law, for which principle examiner is not responsible.

Furthermore, counter to the impression given on pages 6 and 7 of Remarks, examiner cannot find any evidence or any recitation on his part in the actual rejection of his reliance on mean values. Previous "Response to Arguments" did discuss how applicants' inequality holds up for the mean values, but this was only in response to allegation of a narrowness of range over which the inequality is satisfied. On the contrary: the required thickness in conjunction with an end point of the boron concentration range (hence necessarily reduced to practice) was shown to satisfy the inequality as claimed.

On the recited overlap, applicants admit as much (see final paragraph of page 7). As to the "minuscule" overlap (as discussed on page 8 of Remarks), examiner has provided counterarguments showing through the discussion on mean value that the inequality itself is rather sturdily achieved. Even arguendo, overlap is overlap, and examiner finds no reason to disregard case law holding that overlap constitutes a priori obviousness when even no overlap does so when the differences in the ranges are



close enough such that one skilled in the art would have expected to result in the same properties, again with reference to *In re Peterson* as cited in the rejection.

Finally, with regard to the amendment to the claim language, the minimum boron concentration ([0149]) in the prior art and the required thickness is implemented after the boron concentration ([0149]-[0150]). Therefore, independent process steps determine thickness and boron concentration and consequently the claim limitation as newly amended, i.e., "required thickness" "within said range of said boron concentration" is met by the primary reference (Yonehara et al).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt whose telephone number is 571-272-1919. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JPM  
February 5, 2007

Primary Examiner:

  
Johannes Mondt (TC 3600, Art Unit: 3663)